

REMARKS

All the claims presently in this application have been made subject to a restriction requirement wherein the Official Action submits that the fifteen claims of the present application are directed to two distinct and independent inventions. The two inventions alleged to be included in the fifteen claims of the present application are as follows:

- I. Claims 15-26 and 29-30 drawn to a method of inhibiting or reducing angiogenesis in a mammal.
- II. Claims 27-28 drawn to a method of in vitro diagnosis

In response to the above-described restriction requirement, applicants have provisionally elected, with traverse, Group I, drawn to a method of inhibiting or reducing angiogenesis in a mammal, which is encompassed by Claims 15-26 and 29-30; N-[4-(1-benzoyl-piperidin-4-yl)-butyl]-3-(pyridin-3-yl)-acrylamide as listed in Claim 22 and, inflammatory disorder as a specific disease which is encompassed by claims 15-24, 26 and 29 as well as claim 27 (allegedly belonging to Group II) for prosecution on the merits in this application. Applicants hereby reserve their right to file a divisional application(s) directed to the non-elected subject matter in this application.

Furthermore, pursuant to 37 C.F.R. §§1.111 & 1.143, Applicants hereby traverse the Examiner's requirement for restriction and request reconsideration thereof for the following reasons.

A requirement for restriction presupposes an analysis of the subject application in light of the rules governing the practice, i.e., 37 C.F.R. §1.499 and PCT Rule 13.1 and 13.2. PCT Rule 13.1, first sentence, states: "The international application shall relate to one invention only as to a group of inventions so linked as to form a single general inventive concept ('requirement of unity of invention')." (Emphasis added). PCT Rule 13.2 states: The

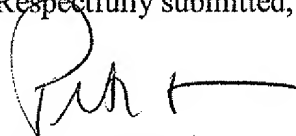
expression “technical feature” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. (Emphasis added).

In the Official Action, the Examiner contends that Groups I, and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature. In response, applicants submit that Groups I and II are linked by a special technical feature as to form a single general inventive concept. Specifically, Group I is directed to a method of inhibiting or reducing angiogenesis in a mammal, Group II is drawn to a method of in vitro diagnosis comprising the compound employed in the method of Claim 15 (Group I). Moreover, the Examiner concedes that the diseases to be treated share the common technical feature of administration of the compounds of claim 15. Therefore, Groups I and II are interrelated and interdependent, and thus they are linked by a special technical feature as to form a single general inventive concept. Accordingly, consistent with 37 C.F.R. §1.475(b), applicants respectfully request that the United States Patent and Trademark Office should consider withdrawing the imposed restriction requirement and examining all claims in the instant application.

As to the citation to Biedermann (WO 97/486696), applicants respectfully submit that unity of invention, not novelty, is the issue at hand. Applicants should be given the opportunity to argue the merits during prosecution, i.e. whether the claims are novel over the prior art. Restriction of the claims at the stage would deny applicants such an opportunity.

In view of the foregoing comments, it is respectfully urged that the Examiner withdraw the requirement for restriction and provide an action on the merits with respect to all of the claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Peter I. Bernstein', with a long horizontal stroke extending to the right.

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